

REMARKS

In the current office action, the claims are rejected under 35 USC §112, second paragraph, as indefinite because the group R⁹ is not defined in the claims. Claims 1-8 are also rejected under the judicially created doctrine of obviousness-type double patenting. These are addressed below.

35 USC §112, Second Paragraph

The claims are rejected because R⁹ is not defined in Claim 1. A definition of R⁹ as being H or C₁₋₃alkyl has been incorporated into Claim 1 in the amendment. This amendment to Claim 1 is supported by the fact that some of the substituent groups that are defined using R⁹ in Claims 1 and 11 have specific values of H and C₁₋₃alkyl in other claims.

For example, the substituent group R¹ in Claim 1 includes -NHC(=NH)NH₂ as selection (t), whereas R¹ in Claim 11, selection (i), is defined as -NHC(=NH)NR⁹R¹⁰. The definitions of R⁹ and R¹⁰ have to include H as one choice for internal consistency. The definition of R¹⁰ already includes H, and H must also be a choice for R⁹. The definition of R¹ as including -NHC(=NH)NR⁹R¹⁰ was inserted into Claim 1, since this encompasses the group that is currently in Claim 1.

The definition of R² in Claim 1 includes phenyl and heterocyclic groups that are substituted with several groups, including CO₂R⁹ as selection (n). In Claim 13, the substituents on the equivalent phenyl and heterocyclic groups include -CO₂H and -CO₂C₁₋₃alkyl. For consistency, R⁹ in Claim 1 must include H and C₁₋₃alkyl as part of its definition. A definition of R⁹ as H or C₁₋₃alkyl was therefore added to Claim 1.

R¹ in Claim 1 was further amended to include several substituents that appear in the examples but were not included in the generic claim. This obviously is an oversight. R¹ in Claim 1 therefore has additional definitions that include the substituents on the heterocyclic substituents in the following examples, which are provided in Claim 27:

- Examples 45, 51, 80 and 81: -NHAc;
- Example 46: -NHCO₂CH₃;
- Example 35: -CH₂C(=O)NHCH₃; and
- Example 36: -CH₂C(=O)N(CH₃)₂.

Obviousness-Type Double Patenting

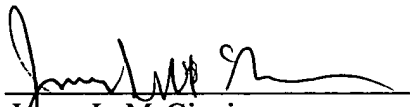
The cited reference was granted as US Patent 7,410,961, on August 12, 2008. There is no double patenting issue with respect to the '961 patent, because the claims do not overlap. There are no possible compounds that are included within the scope of both the '961 patent and the current claims. Note that in the '961 patent, the groups R¹⁶ and R¹⁸ together form a bridge, whereas the analogous groups in the instant claims are H. Thus, there must be a bridge in the '961 patent, and there cannot be a bridge in the instant claims. The double patenting rejection should be withdrawn.

All of the grounds for rejection have been overcome. The claims are in condition for allowance. Such allowance is earnestly solicited.

A fee is not believed to be required with this timely response. If any fee is required, the fee may be charged to Merck Deposit Account No. 13-2755.

If the examiner needs to discuss any matter relating to this application, the examiner is invited to telephone the undersigned attorney at the number below.

Respectfully submitted,

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